

REMARKS

Claims 1-7, 9-17, 19-25, 27-37, 39-66 and 68-70 are pending in the present application. By this response, claims 1, 48 and 65 are amended. Claims 1, 48 and 65 have been amended to recite "responsive to a request to change a font attribute of the selected portion, instruction means for inserting virtual font indicators before and after text within the selected portion and responsive to a request to identify a page break in the selected portion, inserting at least one virtual page break indicator within the selected portion." Support for these amendments may be found at least on page 26, line 12 to page 27, line 10 and on page 21, line 24 to page 22, line 12 of the current specification. Reconsideration of the claims in view of the above amendments and the following remarks is respectfully requested.

I. Claim 52

As previously presented in the response filed June 4, 2004, Applicants respectfully submit that claim 52 is not rejected under any combination of references in the Office Action dated March 8, 2004 or the present Office Action.

II. 35 U.S.C. § 103, Alleged Obviousness, Claims 1-4, 9-12, 48-50 and 65

The Office Action rejects claims 1-4, 9-12, 48-50 and 65 under 35 U.S.C. § 103(a) as being unpatentable over *Page Frame Feature for Printing Electronic Documents*; International Business Machines Research Disclosure; May 1999, pages 688-690 in view of Tsimelzon (U.S. Patent No. 6,763,388 B1). This rejection is respectfully traversed.

As to claim 1 the Office Action states:

Regarding independent claim 1, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page 688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches

a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents. Tsimelzon does teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and second web document are markup language documents in fig. 3-4, col. 5 lines 15-16, and col. 5 line 37 – col. 6 line 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Disclosure so that the preview could have been editable by the user without affecting the original web page.

Office Action dated September 28, 2004, pages 2-3.

Claim 1, which is representative of the other rejected independent claims 12, 14 and 25 with regard to similarly recited subject matter, reads as follows:

1. A method in a web browser on a data processing system for processing a document, the method comprising:
 - receiving a first web document including formatting information used to display the first web document;
 - receiving a request to present a selected portion of the first web document;
 - identifying formatting information associated with the selected portion of the first web document;
 - creating in the web browser a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving the request, wherein the first web document and the second web document are markup language documents;
 - responsive to a request to change a font attribute of the selected portion, inserting virtual font indicators before and after text within the selected portion; and
 - responsive to a request to identify a page break in the selected portion, inserting at least one virtual page break indicator within the selected portion. (emphasis added)

IBM Research Disclosure and Tsimelzon, taken alone or in combination, fail to teach or suggest responsive to a request to change a font attribute of the selected portion, inserting

virtual font indicators before and after text within the selected portion and responsive to a request to identify a page break in the selected portion, inserting at least one virtual page break indicator within the selected portion.

The Office Action acknowledges that the IBM Research Disclosure does not teach "modifying the font attribute of a selected portion of a web document" and "inserting additional page breaks indicators into the second web document." (See page 6, second paragraph and page 18, third paragraph) Applicants respectfully submit that Tsimelzon also fails to teach or suggest these features. Nowhere in any section of the Tsimelzon reference are font attributes changed or virtual page break indicators inserted. Moreover, neither reference teaches or suggests changing font attributes by inserting virtual font indicators before and after text within the selected portion of a web document or identifying page breaks by inserting at least one virtual page break indicator within the selected portion of a web document. Web documents are intended to provide information to a user and not to have the contents within the web document edited by changing font size. This is evident in the teachings of the IBM Research Disclosure and Tsimelzon, as nowhere in either reference is the editing of font within a web page or HTML document taught or suggested.

Furthermore, there is not so much as a suggestion in either reference to modify the references to include such features. That is, there is no teaching or suggestion in the IBM Research Document or Tsimelzon that a problem exists for which inserting virtual font indicators before and after text within the selected portion of a web document to change a font attribute or inserting at least one virtual page break indicator within the selected portion of a web document, is a solution. The IBM Research Document and Tsimelzon, either alone or in combination, do not teach or suggest changing font attributes within web documents or inserting virtual page breaks. Neither of the references even recognizes a need to change a font attribute of a selected portion of a web document or inserting virtual page breaks within a selected portion of a web document, as recited in claim 1.

Moreover, neither reference teaches or suggests the desirability of incorporating the subject matter of the other reference. That is, there is no motivation offered in either reference for the alleged combination. As discussed above, web documents are intended

to provide information to a user and not to have the contents within the web document edited by changing font size, other font attributes or inserting page breaks. Neither of the references changes a font attribute or inserts virtual page breaks within a web document. Thus, the only teaching or suggestion to even attempt the alleged combination is based on a prior knowledge of Applicants' claimed invention thereby constituting impermissible hindsight reconstruction using Applicants' own disclosure as a guide.

One of ordinary skill in the art, being presented only with IBM Research Document and Tsimelzon, and without having a prior knowledge of Applicants' claimed invention, would not have found it obvious to combine and modify IBM Research Document and Tsimelzon to arrive at Applicants' claimed invention. To the contrary, even if one were somehow motivated to combine IBM Research Document and Tsimelzon, and it were somehow possible to combine the systems, the result would not be the invention, as recited in claim 1. The result would be simply selecting a portion of a web page and displaying it in a second web document. The resulting system still would not insert virtual font indicators before and after text within the selected portion in response to a request to change a font attribute of the selected portion or insert at least one virtual page break indicator within the selected portion in response to a request to identify a page break in the selected portion within a web document.

In view of the above, Applicants respectfully submit that the IBM Research Disclosure and Tsimelzon, taken alone or in combination, fail to teach or suggest the features of claims 1, 48 and 65. At least by virtue of their dependency on claims 1 and 48, the features of dependent claims 2-4, 9-12 and 49-50 are not taught or suggested in the IBM Research Disclosure and Tsimelzon, whether taken individually or in combination. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 1-4, 9-12, 48-50 and 65 and 66 under 35 U.S.C. § 103(a).

III. 35 U.S.C. § 103, Alleged Obviousness, Claims 5, 13-17, 19-25, 27-31, 51, 53-59 and 66

The Office Action rejects claims 5, 13-17, 19-25, 27-31, 51, 53-59 and 66 under 35 U.S.C. § 103(a) as being unpatentable over *Page Frame Feature for Printing*

Electronic Documents; International Business Machines Research Disclosure; May 1999, pages 688-690 in view of Tsimelzon (U.S. Patent No. 6,763,388 B1) and Kim (U.S. Patent No. 6,330,577 B1). This rejection is respectfully traversed.

As to claim 13 the Office Action states:

Regarding independent claim 13, IBM Research Disclosure teaches receiving a first web document including formatting information used to display the first web document in page 688. IBM Research Disclosure teaches receiving a request to obtain a selected portion of the document in fig. 4 and pages 689-690. IBM Research Disclosure teaches a print preview feature in page 688 which generates another representation of the document from the selected portion.

IBM research disclosure does not teach creating a second web document including the second portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and the second web document are markup language documents. Tsimelzon does teach creating a second web document including the selected portion and the formatting information associated with the selected portion, in response to receiving a request, wherein the first web document and the second web document are markup language documents in fig. 3-4, col.5 lines 15-16, and col. 5, line 37 to col. 6 lines 15.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have used the teaching of Tsimelzon to have enhanced the print preview of IBM Research Document so that the preview could have been editable by the user without affecting the original web page.

IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable to have allowed for the changing of the font so that the user could have modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

Office Action dated September 28, 2004, pages 6-7.

Claim 13, which is representative of the other rejected independent claims 53 and 66 with regard to similarly recited subject matter, reads as follows:

13. A method in a web browser on a data processing system for processing a document, said method comprising:
- receiving a first web document;
 - receiving a request to change a font attribute of a selected portion of the first web document; and
 - creating in the web browser a second web document from the first web document, wherein the font attribute, within the second web document, of the selected portion is changed in response to receiving the request to change the font attribute of the selected portion, wherein the first web document and the second web document are markup language documents..

Applicants respectfully submit that the IBM Research Disclosure, Tsimelzon and Kim, taken alone or in combination, fail to teach or suggest receiving a request to change a font attribute of a selected portion of the first web document.

The deficiencies of the IBM Research Disclosure and Tsimelzon have been addressed above. That is, the IBM Research Disclosure and Tsimelzon fail to teach or suggest changing a font attribute within a web document; however, the Office Action alleges that Kim teaches this feature.

Kim is directed to a method for displaying font information by using a font preview window, when the user makes up a document, the sample of the desirable font is promptly shown to the user through the font preview window. While Kim may teach changing fonts in a document, Kim does not teach or suggest changing fonts or font attributes in a web document. Web documents are intended to provide information to a user and not to have the contents within the web document edited by changing font size. This is evident in the teachings of Kim, as nowhere in the Kim reference is the editing of font within a web page or HTML document taught or suggested. Thus, Kim does not provide for the deficiencies of the IBM Research Disclosure and Tsimelzon. In that, Kim does not teach or suggest inserting virtual font indicators before and after text within the selected portion in response to a request to change a font attribute of the selected portion.

In view of the above, Applicants respectfully submit that the IBM Research Disclosure, Tsimelzon and Kim, taken alone or in combination, fail to teach or suggest the features of claims 1, 13, 48, 53 and 66. At least by virtue of their dependency on claims 1, 13, 48 and 53, the features of dependent claims 14-31 and 54-59 are not taught or suggested in the IBM Research Disclosure, Tsimelzon and Kim, whether taken

individually or in combination. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 13-31, 53-59 and 66 under 35 U.S.C. § 103(a).

Moreover, in addition to their dependency from independent claims 1, 13, 48 and 53, the features of dependent claims 5, 14-31, 51 and 54-59 are not taught or suggested by the alleged combination of the IBM Research Disclosure, Tsimelzon and Kim, taken individually or in combination. For example, with regard to claims 5 and 51, the IBM Research Disclosure, Tsimelzon and Kim, taken alone or in combination, fail to teach or suggest receiving a request to change a font attribute of a selected portion of the second web document. As shown above, the IBM Research Disclosure, Tsimelzon and Kim, taken alone or in combination, fail to teaches or suggest changing any font attributes within web documents. Thus, the IBM Research Disclosure and Kim, taken alone or in combination, fail to teach or suggest the specific features recited in claims 5 and 51.

As an additional example, with regard to claims 14 and 54, the IBM Research Disclosure, Tsimelzon and Kim, taken alone or in combination, fail to teach or suggest where the step of creating the second web document includes inserting virtual font indicators before and after text within the selected portion. As shown above, the IBM Research Disclosure, Tsimelzon and Kim, taken alone or in combination, fail to teaches or suggest changing any font attributes within web documents. Thus, it follows that the IBM Research Disclosure, Tsimelzon and Kim, taken alone or in combination, also fail to teach or suggest the features as recited in claims 14 and 54.

Therefore, in addition to being dependent on independent claims 1, 13, 48 and 53, dependent claims 5, 14-31, 51 and 54-59 are also distinguishable over the IBM Research Disclosure, Tsimelzon and Kim by virtue of the specific features recited in these claims. Accordingly, Applicants respectfully request withdrawal of the rejection of dependent claims 5, 14-31, 51 and 54-59 under 35 U.S.C. § 103 (a).

IV. 35 U.S.C. § 103, Alleged Obviousness, Claims 7, 32-37, 39-46, 60-63 and 67

The Office Action rejects claims 7, 32-37, 39-46, 60-63 and 67 under 35 U.S.C. § 103(a) as being unpatentable over *Page Frame Feature for Printing Electronic Documents*; International Business Machines Research Disclosure; May 1999, pages 688-

690 in view of Tsimelzon (U.S. Patent No. 6,763,388 B1) and Michelman et al. (U.S. Patent No. 6,487,567 B1). This rejection is respectfully traversed.

Claim 7 is dependent on independent claim 1 and, thus, these claims distinguish over the IBM Research Document and Tsimelzon for at least the reasons noted above with regards to claim 1. Moreover, Michelman does not provide for the deficiencies of the IBM Research Document and Tsimelzon and, thus, any alleged combination of the IBM Research Document, Tsimelzon and Michelman would not be sufficient to reject independent claim 1 or claim 7 by virtue of its dependency. That is, Michelman does not teach or suggest inserting virtual font indicators before and after text within the selected portion in response to a request to change a font attribute of the selected portion.

As to claim 32, the Office Action states:

Regarding independent claim 32, IBM Research Disclosure does not teach inserting additional page breaks indicators into a web document. Michelman does teach manipulating page breaks and page break indicators in a document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Document so that the page margins and page breaks indicators could have been modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have implemented this combination so that the user could have further control in preparing the display of the selected portion of the document for output to either a display or a printer.

Claim 32, which is representative of the other rejected independent claims 60 and 67 with regard to similarly recited subject matter, reads as follows:

32. A method in a web browser on a data processing system for processing a document, the method comprising:
receiving a first web document;
receiving a request to display page break indicators within the first web document;
identifying page break information for the first web document for an output device; and
creating in the web browser a second web document from the first web document, wherein at least one virtual page break indicator is inserted into the second web document, in response to the page break information, to indicate the location of page breaks, wherein the first web document and the second web document are markup language documents.

Applicants respectfully submit that the IBM Research Disclosure, Tsimelzon and Michelman, taken alone or in combination, fail to teach or suggest where at least one virtual page break indicator is inserted into the second web document. The Office Action acknowledges that the IBM Research Document fails to teach "inserting additional page break indicators into a second web document." Applicants respectfully submit that Tsimelzon also fails to teach or suggest these features. However, the Office Action alleges that Michelman teaches these features.

Michelman does not provide for the deficiencies of the IBM Research Disclosure and Tsimelzon. That is, Michelman does not teach or suggest where at least one virtual page break indicator is inserted into the second web document. Michelman is directed to a system for manipulating page-breaks in an electronic document. A user interface process provides a graphical user interface allowing a user to select a page-break within an electronic document and then identify a new location for the page-break. A system process performs the steps of moving the selected page-break to the new location and adjusting the scaling and the automatic page-breaks for the remainder of the document to accommodate the page-break at the new location. Nowhere, in the Michelman reference are page break indicators inserted into a web document. Web documents are intended to provide information to a user and not to have the contents within the web document edited by inserting page break indicators. This is evident in the teachings of the IBM Research Disclosure and Tsimelzon, as nowhere in either reference is inserting page break indicators within a web page or HTML document taught or suggested. While, Michelman may teach selecting page breaks within an electronic document, Michelman does not teach or suggest inserting a virtual page break indicator into a web document. Any conclusion that it would have been obvious to include a second web document in the system of Michelman must be based entirely on a hindsight reconstruction of Applicants' claimed invention having first had benefit of Applicants' disclosure. However, even if the references were combinable and there were a suggestion to combine them in the manner alleged by the Office Action, the result would not be the claimed invention because none of the references teaches the features emphasized above with regard to independent claims 32, 30 and 67.

In view of the above, Applicants respectfully submit that the IBM Research Disclosure, Tsimelzon and Michelman, taken alone or in combination, fail to teach or suggest the features of claims 1, 32, 60 and 67. At least by virtue of its dependency on claims 1, 32 and 60, the specific features of dependent claims 7, 33-37, 39-46 and 61-63 are not taught or suggested in the IBM Research Disclosure, Tsimelzon and Michelman, whether taken alone or in combination. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 7, 32-37, 39-46, 60-63 and 67 under 35 U.S.C. § 103(a).

V. 35 U.S.C. § 103, Alleged Obviousness, Claims 6, 47, 64 and 68-70

The Office Action rejects claims 6, 47, 64 and 68-70 under 35 U.S.C. § 103(a) as being unpatentable over *Page Frame Feature for Printing Electronic Documents*; International Business Machines Research Disclosure; May 1999, pages 688-690 in view of Tsimelzon (U.S. Patent No. 6,763,388 B1), Kim (U.S. Patent No. 6,330,577 B1) and Michelman et al. (U.S. Patent No. 6,487,567 B1). This rejection is respectfully traversed.

Claim 6 is dependent on independent claim 1 and, thus, these claims distinguish over the IBM Research Document, Tsimelzon and Kim for at least the reasons noted above with regards to claims 1 and 5. Moreover, Michelman does not provide for the deficiencies of the IBM Research Document, Tsimelzon and Kim and, thus, any alleged combination of the IBM Research Document, Tsimelzon, Kim and Michelman would not be sufficient to reject claim 1 and 5 or claim 6 by virtue of its dependency. That is, Michelman does not teach or suggest inserting virtual font indicators before and after text within the selected portion in response to a request to change a font attribute of the selected portion.

As to claims 47, 64 and 68-70, the Office Action states:

Regarding independent claim 47, IBM Research Disclosure does not teach modifying the font attribute of a selected portion of a web document. Kim teaches modifying the font attribute of a selected portion of a document in fig. 4-5, 8, and the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined Tsimelzon and Kim into IBM Research Disclosure to have created the claimed invention. It would have been obvious and desirable

to have allowed for the changing of the font so that the user could have modified the selected portion of the web page so that it would have been more legible when outputted to the display or printer.

IBM Research Disclosure does not teach inserting additional page breaks indicators into a web document. Michelman does teach manipulating page breaks and page break indicators in a document in the abstract. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the IBM Research Disclosure so that the page margins and page breaks indicators could have been modified after the initial frame selection setting up the page breaks for the initial page. It would have been obvious and desirable to have implemented this combination so that the user could have had further control in preparing the display of the selected portion of the document for output to either a display or a printer.

Office Action dated September 28, 2004, pages 24-25.

Claim 47, which is representative of the other rejected independent claims 64, 68 and 69 with regard to similarly recited subject matter, reads as follows:

47. A method in a web browser on a data processing system for processing a document, the method comprising:
receiving a first web document;
receiving a request to perform an action, wherein the request to perform an action comprises one of a request to present a selected portion of the first web document, a request to change a font attribute of a selected portion of the first web document, and a request to display page break indicators within the first web document; and
creating in the web browser a second web document comprising at least a portion of the first web document in response to receiving the request, wherein the first web document and the second web document are markup language documents.

Applicants respectfully submit that the IBM Research Disclosure, Tsimelzon, Kim and Michelman, taken alone or in combination, fail to teach or suggest a request to change a font attribute of a selected portion of the first web document.

The deficiencies of the IBM Research Disclosure, Tsimelzon, Kim and Michelman are addressed above. That is, the IBM Research Disclosure, Tsimelzon, Kim and Michelman, taken alone or in combination, fail to teach or suggest changing a font attribute of a selected portion of a web document or inserting at least one virtual page break indicator into a web document. Moreover, there is no teaching or suggestion in any of the references to change a font attribute or insert a virtual page break indicator within a

web document. Any conclusion that it would have been obvious to change a font attribute or insert a virtual page break indicator within a web document in the IBM Research Disclosure, Tsimelzon, Kim or Michelman must be based entirely on a hindsight reconstruction of Applicants' claimed invention having first had benefit of Applicants' disclosure. However, even if the references were combinable and there were a suggestion to combine them in the manner alleged by the Office Action, the result would not be the claimed invention because none of the references teaches or suggest changing font attributes or inserting a virtual page break indicator within a web document as recited in independent claims 47, 68 and 69.

Claim 70, reads as follows:

70. A computer system having stored therein a web browser application, the system comprising:
- interface means for allowing the user to interface with the web browser application;
 - communication means for receiving a first web document form a network;
 - creation and editing means for creating a second web document, wherein the creation and editing means has a plurality of modes of operation including:
 - a first mode of operation in which the creation and editing means receives a request from the interface means to present a selected portion of the first web document, identifies formatting information associated with the selected portion of the first web document, and creates in the web browser a second web document consisting of the selected portion and the associated formatting information in response to receiving the request;
 - a second mode of operation in which the creation and editing means receives a request from the interface means to change a font attribute of a selected portion of the first web document, and creates in the web browser a second web document from the first web document, wherein the font attribute of the selected portion within the second web document is changed in response to receiving the request to change the font attribute of the selected portion; and
 - a third mode of operation in which the creation and editing means receives a request from the interface means to display page break indicators within the first web document, identifies page break information corresponding to the first web document, and creates in the web browser a second web document from the first web document, wherein at least one virtual page break indicator is inserted into the second web document, in response to the page

break information, to indicate the location of page breaks, wherein the first web document and the second web document are markup language documents.

Applicants respectfully submit that the IBM Research Disclosure, Tsimelzon, Kim and Michelman, taken alone or in combination, fail to teach or suggest changing a font attribute of the selected portion or inserting a virtual page break indicator within a web document in response to receiving the request to change the font attribute of the selected portion. The deficiencies of the IBM Research Disclosure, Tsimelzon, Kim and Michelman are addressed above. That is, the IBM Research Disclosure, Tsimelzon, Kim and Michelman, taken alone or in combination, fail to teach or suggest changing a font attribute or inserting a virtual page break indicator within a web document. Moreover, there is no teaching or suggestion in any of the references to change a font attribute or insert a virtual page break indicator within a web document. Any conclusion that it would have been obvious to change a font attribute within a web document in the IBM Research Disclosure, Tsimelzon, Kim or Michelman must be based entirely on a hindsight reconstruction of Applicants' claimed invention having first had benefit of Applicants' disclosure. However, even if the references were combinable and there were a suggestion to combine them in the manner alleged by the Office Action, the result would not be the claimed invention because none of the references teaches or suggest changing a font attribute or insert a virtual page break indicator within a web document as recited in independent claim 70.

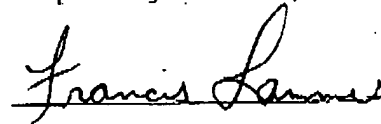
In view of the above, Applicants respectfully submit that the IBM Research Disclosure, Tsimelzon, Kim and Michelman, taken alone or in combination, fail to teach or suggest the features of claims 1, 47 and 68-70. At least by virtue of its dependency on claim 1, the features of dependent claim 6 is not taught or suggested in the IBM Research Disclosure, Tsimelzon, Kim and Michelman, whether taken alone or in combination. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 6, 47 and 68-70 under 35 U.S.C. § 103(a).

VI. Conclusion

It is respectfully urged that the subject application is patentable over the prior art of record and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

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